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EXAMINER	
VAUGHAN, MICHAEL R	
ART UNIT	PAPER NUMBER
2431	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/577,158	KSONTINI ET AL.	
	Examiner	Art Unit	
	MICHAEL R. VAUGHAN	2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-28,30-32 and 34-40* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-28, 30-32, and 34-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The instant application having Application No. 10/577,158 is presented for examination by the examiner. Claims 21 and 39 are amended; claims 29 and 33 are canceled. As such, claims 21-28, 30-32, and 34-40 remain pending.

Response to Amendment

Claim Objections

Claim objections are withdrawn due to amendments.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 21-28, 30-32, and 34-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 21 and 39, the newly amended limitation results in confusion as to how the claimed invention operates. The preamble now states that the method is carried out on at least one of each initialization, activation, or deactivation of the at least one additional application. First of all, when read with the rest of the preamble, the grammar and sentence structure does not make much sense. Secondly, in the body of

the claim, it is the one resource or functions of the security module that are activated or deactivated. Therefore, it is not clear how the method being carried out actually causes initialization, activation, or deactivation, **of the additional application** because this step is not actually performed by the claimed method. In other words the cause and effect relationship is not definitively claimed. Appropriate correction is required.

Response to Arguments

Applicant's arguments filed 10/7/10 have been fully considered but they are not persuasive. Applicant alleges that the combination of Parker and Dutta fail to disclose the subject matter of the independent claims. It is alleged that Parker and Dutta do not teach:

> selectively activating or deactivating at least one resource as data or functions stored in said security module by executing the instructions included in the cryptogram and using the selected resource to condition the functioning of the at least one additional application stored in the equipment according to criteria established by at least one of a supplier of said additional application, the operator and a user of the equipment,
>
> wherein the resources as data or functions of the security module used by the main application are left active for connection of the equipment to the network so as to obtain further cryptograms from the control server.

Examiner respectfully disagrees with this allegation. In the last office action, dated 7/19/10, Examiner already stated that Parker is silent in explicitly teaching selectively activating or deactivating at least one resource as data or functions stored in said security module by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the at one additional application stored

in the equipment according to criteria established by at least one of a supplier of said additional application, the operator, or the user of the equipment, wherein the resources as data or functions of the security module used by the main application are left active for connection of the equipment to the network so as to obtain further cryptogram from the control server. Also in that same action, the mechanics of Dutta were shown to teach these features (also see below). In an effort to distinguish the teachings of Dutta from those of the claimed invention, Applicant expresses that the "claimed" invention automatically receives identification data and manages security from the control server and even lists specific opportunities as to when this may occur (see page 12 of Applicant's response filed 10/7/10). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., **automatic managing from the control server**) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant attempts to differentiate the claimed invention from Dutta by insinuating that the user controls the remote activation and reactivation whereas as the claimed invention does this automatically from the control server. After careful consideration of the claims, particularly claim 21, the selectively activating or deactivating is not directly performed by the control server. The control server generates and transmits the cryptogram. It appears from the claim that one additional application is managed by at least one of a supplier, the operator, or the user of the equipment. Applicant admits that the user of

Dutta is responsible in part for the activating and deactivating. Therefore, since both Dutta and the claimed invention can rely upon the user to manage this control over the phone, they are indistinguishable. As such the claimed requires no more than is taught by the prior art.

In further attempts to show that a proper prima facie case of obviousness has not been shown by the Examiner, Applicant purports that no explicit rationale was disclosed by the Examiner. To the contrary Examiner has shown that two teachings both related to the securing of resources in cell phones, can obviously be combined when the result of such combination yields a predictable result. The yielded result is, inter alia, improved security and greater control remotely over the phone. One of ordinary skill in the art can appreciate these results from the combination of Parker and Dutta. Therefore, Examiner maintains that a proper prima facie case of obviousness has been established.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 21-28, 30-32, and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over USP 5,864,757 to Parker in view of USP Application Publication 2002/0186845 to Dutta et al., hereinafter Dutta.

As per claim 21, Parker teaches a method for managing the security of at least one additional application associated to a main application with a security module of an equipment connected, via a network, to a control server managed by an operator, the main application and the additional applications use resources as data or functions stored in a security module [SIM] locally connected to said equipment, comprising the following preliminary steps:

receiving via the network, by the control server identification data comprising at least the type and software version of the equipment (col. 6, line 46) and the identity of the security module (col. 1, lines 50-55 and col. 8, lines 21-25),

analyzing and verifying by the control server of said data (col. 8, lines 26-28),

generating, by the control server, a cryptogram (col. 8, lines 41-44) from the result of the verification of said data,

transmitting, by the control server, the cryptogram, via network and the equipment, to the security module (col. 8, lines 60-65),

receiving and analyzing the cryptogram by the security module for acting on specific application according to instructions included in the cryptogram (col. 9, lines 50-55).

Parker is silent in explicitly teaching the method being carried out on at least one of each initialization, activation, or deactivation of the at least one additional application and selectively activating or deactivating at least one resource as data or functions stored in said security module by executing instructions included in the cryptogram and using the selected resource to condition the functioning of the at one additional application stored in the equipment according to criteria established by at least one of a supplier of said additional application, the operator, or the user of the equipment, wherein the resources as data or functions of the security module used by the main application are left active for connection of the equipment to the network so as to obtain further cryptogram from the control server.

Dutta teaches the above limitation as selectively controlling resources of a security element (SIM) from application of the mobile phone wherein the main application (connectivity to the network) is left active (0007-0010). Dutta basically teaches the authentication functions and other secured functions are disabled remotely. This prevents **additional applications** such as web browsers (inherently for e-commerce transactions) from gaining access to security keys and other secured data stored in the SIM. The phone's ability to stay on the network is taught as a means to receive further remote commands and to respond to the security alert by sending acknowledgments and other location specific data (0021 and 0040). By rendering the e-commerce functions disabled, the application for performing e-commerce is effectively disabled (0007). As such the e-commerce application is interpreted as one of a type of additional applications.

For purposes of examination, the main application is interpreted as the main network connectivity application and the additional applications are some software functions (such as web browsers and e-commerce transactions) other than the main calling application. Parker discloses locking down a phone to only emergency calls. Even in the emergency mode the phone is sill able to connect to the network. Deactivating just the security functions allows the phone to stay on the network, send acknowledgements of the remote commands, and report its location. Being able to perform these functions while still preventing a malicious user from acquiring the secure data of the legitimate user is an obvious reason for combining these two teachings. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combined the teaching of Dutta with those of Parker to give service providers control over not only the calling functions of a cell phone but also the applications running on them in order to safeguard the SIM data.

As per claim 22, Parker teaches the equipment is a mobile equipment of mobile telephony (see abstract).

As per claim 23, Parker teaches the network is a mobile network of the GSM, GPRS or UMTS type (col. 1, line 36).

As per claim 24, Parker teaches the security module is a subscriber module of a SIM card type inserted into the mobile equipment of mobile telephony (col. 1, line 50).

As per claim 25, Parker teaches the identification of the set mobile equipment / subscriber module is carried out from the identifier of the mobile equipment and from

the identification number of the subscriber module pertaining to a subscriber to the mobile network (col. 8, lines 55-65).

As per claim 26, Parker teaches the criteria [locked/unlocked] defines the usage limits [activate / deactivate] of an application according to the risk [key exposure] associated to said application and to the type and the software version of the mobile equipment that the operator and/or the application supplier and/or the user of the mobile equipment want to take in account (col. 9, lines 2-4). Upon activating a locked phone, Parker teaches a phone can be relocked if a key is compromised and needs to be changed. This process takes into account the identity information inside the phone, including the SIM.

As per claim 27, Parker teaches the activation method is carried out after each connection of the mobile equipment to the network (col. 9, line 11). A check is made at turn on to see if the device is locked. It does however bypass the rest of the activation method and goes to the authentication part of the method if the check is satisfied.

As per claim 28, Parker teaches the activation method is carried out after each of updating the software version of the mobile equipment (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 30, Parker teaches the activation method is carried out after each updating of the software version of the subscriber module (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 31, Parker teaches the activation method is out after each updating of the resources on the subscriber module (col. 9, lines 1-5). Anytime the phone receives a new subscriber identification code it is necessary for the handset to re-register with the base station.

As per claim 32, Parker teaches the activation method is carried out periodically at a rate [each startup] given by the control server (col. 9, line 11).

As per claim 34, Parker teaches the subscriber module, prior to the execution of the instructions given by the cryptogram, compares the identifier of the mobile equipment with that previously received (Fig. 5, 172).

As per claim 35, Parker teaches the control server, prior to the transmission of the cryptogram, compares the identifier of the mobile equipment with that previously received and only initiates the verification operation if the identifier has changed (col. 8, lines 55-65). This activation is only done a second time if the SIM or any of its values change. Otherwise, the server already knows the phone is ok and does not send it a new IMSI.

As per claim 36, Parker teaches the cryptogram is made up of a message encrypted by the control server with the aid of an asymmetrical or symmetrical encryption key from a data set containing, among other data, the identifier of the mobile equipment, the identification number of the subscriber module, the resource references of the subscriber module and a predictable variable (col. 8, lines 50-59).

As per claim 37, Parker is silent in disclosing the subscriber module transmits to the control server, via the mobile equipment and the mobile network, a confirmation

message when the subscriber module has received the cryptogram, said message confirming the correct reception and the adequate processing of the cryptogram by the subscriber module. Dutta teaches this limitation (0037 and 0040). Examiner supplies the same rationale as recited in the rejection of claim 21 to incorporate leaving the main application functional in order to receive acknowledgement of the phone's deactivation.

As per claim 38, Parker teaches the equipment is a Pay-TV decoder or a computer to which the security module is connected (col. 12, lines 60-65).

As per claim 39, it is rejected for the same reasons as claim 1.

As per claim 40, Parker teaches a subscriber module of the "SIM card" type connected to a mobile equipment (col. 1, lines 50-55).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL R. VAUGHAN whose telephone number is (571)270-7316. The examiner can normally be reached on Monday - Thursday, 7:30am - 5:00pm, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Korzuch can be reached on 571-272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. R. V./

Examiner, Art Unit 2431

/William R. Korzuch/

Supervisory Patent Examiner, Art Unit 2431